

USSN: 10/083,953
Atty. Docket No.: 2002B009
Amdt. Dated March 30, 2004
Reply to Office Action of January 27, 2004

REMARKS/ARGUMENTS

Claims 1-23 are pending. Claims 16-23 stand withdrawn from consideration pursuant to a Restriction Requirement. Claims 1-15 were rejected in the Office Action under 35 U.S.C. Sections 102 and 103. These Rejections will be discussed in the order the Rejections were presented in the outstanding Office Action in relationship to the newly amended claims.

Claims 1, 2, and 3 are amended to clarify that the cavitated layer of the film structures is an oriented layer comprised of a polymeric material. Support for these amendments is found generally throughout the application and specifically at pages 4-9 and the drawings. Claim 15 is amended to recite that the film structure is a biaxially oriented coextruded multi-layer film structure that is stretched in both directions as previously recited in original Claim 15. Support for this amendment is found generally throughout the application and specifically at pages 4-9 and the drawings.

Election/Restriction Requirement

Paragraph 1 of the Office Action re-states the previous Restriction Requirement indicating that Groups I and II are distinct, given that the multi-layer polymer film structure can be made by adhesively binding the base, core, and skin layers rather than coextruding these layers and therefore laminated and coextruded films have a separate status in the art. However, since the product claims under current examination encompass both coextruded and laminated film structures, a search for purposes of examining these claims would by necessity encompass the coextrusion processes for producing films as recited in Claims 16-23. Therefore, it would not be unduly burdensome to examine Claims 16-23 along with Claims 1-15. Reconsideration is respectfully requested.

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Interview

Applicants appreciate the courtesies extended by Examiner Ahmed to their attorney, Dean Simmons, in the telephonic interview on March 25, 2004. In the interview, the Office Action rejections and cited references were discussed. Mr. Simmons agreed that the claim amendments found in this Response would be submitted along with arguments highlighting distinctions over the cited art. Examiner Ahmed indicated she would consider the amendments and arguments when filed.

Rejections Under Section 102

Claims 1, 2, 7, 8, 10, and 13-14 were rejected under 35 U.S.C. Section 102(b) in paragraph 2 of the Office Action as being anticipated by U.S. Patent 5,544,881 to Rua, et al. The linch pin of this rejection is that Rua discloses a multi-layer game card structure having a "latex scratch-off coating" which may comprise from "10-90 wt.% of filler." Therefore, the cavitated layer of the rejected claims is considered to be anticipated by the latex scratch-off layer of Rua. Apparently, the rejection concludes that a layer having "filler" is the same as a cavitated layer. The rejection references the claims of Rua as establishing that the scratch-off layer comprises 10-90 wt.% of filler.

There are many differences between latex layers including fillers and cavitated oriented polymeric film layers. There are other differences between the pending claims and the disclosure of Rua.

However, the Section 102 rejection fails because the latex scratch-off layer of Rua does not contain a filler as relied upon in the Office Action. The rejection appears to confuse the latex scratch-off layer 12 and "the coin rub coating 50" of Rua. The coin rub coating 50 changes color when rubbed with a coin so that game markings may be applied to the multi-layer card. See, column 4, lines 16-59 describing the function of the coin rub layer 50. See, also Table 1 outlining the composition of the coin rub layer as including 10-90 wt.% of a filler. Accordingly, the coin rub layer and the latex layers of Rua are not the same and the latex scratch-off layer does not contain a filler as relied upon in the Section 102 rejection. For this reason alone, the Section 102 rejection fails.

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Paragraph 3 of the Office Action rejects 1, 7-10, and 13-14 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,542,710 to Silverschotz, et al. This rejection is similar to the Section 102 rejection relying upon Rua. Presumably, the scratch-off layer material of Silverschotz is considered to anticipate the cavitated layer of the claimed film structure. Silverschotz simply discloses that the scratch-off material 8 is a material such as Craigseal product 2850-HD manufactured by Craig Adhesives Corp., Newark, New Jersey. No other disclosure of the scratch-off layer material is provided. A review of the Craig Adhesives website does not reveal the composition of the designated material. However, the website does indicate that Craig Adhesives sells various materials to produce "scratch-off coatings". These coatings appear to be water-based coating formulations. There is no suggestion that any of these coatings provide a cavitated layer as recited in the rejected claims. The burden is on the Patent Office to establish a prima facie case of anticipation.

Moreover, Claim 1 is amended to clarify that the cavitated layer is an oriented polymeric layer. There is no indication that the scratch-off coating of Silverschotz is a cavitated oriented polymeric layer. For these reasons, the Silverschotz patent fails to anticipate Claims 1, 7-10, and 13-14.

Rejections Under Section 103

In paragraphs 4-5 of the Office Action, Claims 2-6, 11, 12, and 15 were rejected under 35 U.S.C. Section 103 as being obvious over either the Rua patent or the Silverschotz patent in view of U.S. Patent 6,500,533 to Kong et al. The rejections acknowledge that neither the Rua patent nor the Silverschotz patent disclose a polyolefin comprising 8-50% calcium carbonate. To make the obviousness rejection, the Kong patent is cited as disclosing an opaque polymeric film having resistance to distortion caused by folding or creasing and comprising a polymeric matrix of a polyolefin and cavitating agent such as polycarbonate. The Rejection continues by concluding that it would be obvious to replace the scratch-off layers of the Rua and Silverschotz with the polyolefin layer disclosed by Kong.

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First of all, by stating that the Rua and Silverschotz patents fail to disclose a polyolefin comprising a calcium carbonate, is presumed that the Office Action concludes that Kong discloses a polyolefin layer incorporating calcium carbonate. However, as acknowledged in the Office Action, Kong discloses the use of a **polycarbonate**, not **calcium carbonate**. For this reason alone, the obviousness rejection is not well founded, particularly with respect to Claim 4 reciting incorporation of a calcium carbonate.

However, more generally, the obviousness rejections fail because there is no suggestion or motivation to substitute the polymeric cavitated layers of the Kong film structures for the scratch-off layers of the Rua and Silverschotz structures. In an effort to find a motivation for this substitution, the Office Action asserts that since the Kong film has resistance to distortion caused by folding or creasing, there would be motivation to substitute the cavitated layer for the scratch-off layers because lack of distortion is a property that would be important in a game card.

It is well established that the teaching of a reference as a whole should be considered and that it is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to fully appreciate what the reference clearly suggests. *In re Wesslau*, 147 U.S.P.Q. 391 (C.C.P.A. 1965). The Kong patent discloses multi-layer films not, single-layer films containing only a cavitated layer. Kong advises that films cavitated with polybutylene terephthalate (PBT) alone tend to have a distorted appearance when the films are creased or folded. However, films cavitated with PBT and polycarbonate are more resistant to distortion upon folding or creasing. *See*, column 4, line 66 through line 4 of column 5. Therefore, Kong is referring to the multi-layer film in its entirety as having increased resistance to distortion. The Office Action asserts that it would be obvious to substitute **only the cavitated core layer** of the Kong multi-layer film into the game card structures of Rua and Silverschotz. Since Kong teaches that the entire film structure is resistant to distortion, there is no motivation to substitute only the cavitated core layer of Kong as required by the Section 103 rejections. All of the teachings of Kong must be considered.

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Moreover, there is no suggestion in either the Rua or Silverschotz disclosures that distortion is a problem in game cards having scratch-off layers. Therefore, one would not look to the teachings of Kong to provide a solution for distortion. There is simply no motivation to do so. Substituting the single polymeric cavitated layer of the Kong patent into the non-polymeric game structures of Rua and Silverschotz would only be motivated by the hindsight provided by the present disclosure. Such hindsight is not motivation to combine teachings to render a claimed invention obvious. It is well settled that motivation to modify the prior art must come from the prior art itself. *Pro-Mold & Tool Co. v. Great Lakes Plastic, Inc.*, 37 U.S.P.Q.2d 1626, 1630 (Fed. Cir. 1996). Moreover, there is no indication that the non-polymeric layers of Rua and Silverschotz would even be compatible with an oriented polymeric layer inserted into the game card structures.

For all of these reasons, the Rua and Silverschotz references taken either alone, or in combination with the Kong patent fail to render the Claims 2-6, 11, 12, and 15 obvious under Section 103.

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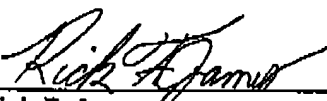
Conclusion

Consistent with the foregoing, Claims 1-15 are believed to be in condition for allowance. Consideration of these claims with an early Notice of Allowance is respectfully requested. Additionally, withdrawal of the Restriction Requirement and examination and allowance of Claims 16-23 is earnestly solicited.

It is believed that this submission is fully responsive to the outstanding Office Action. However, should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number listed below so that all matters may be expeditiously resolved.

Respectfully submitted,

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